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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,130	11/18/2003	Thomas L. Bauer	PHB71792	6979

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EXAMINER

SY, MARIANO ONG

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/716,130

Applicant(s)

BAUER ET AL.

Examiner

Mariano Sy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

1. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 8, 9, 11, 14, and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites the limitation "the spring force axes" in lines 5-6. There is insufficient antecedent basis for this limitation in the claim.

Claim 9 recites the limitation "the spring axes" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "their main spring axis" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "the line of force" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "the suspension" in line 5. It is unclear if applicant is referring to --the suspension device--.

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Claim 14 recites the limitation "the spring packs" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 15 recites the limitation "the spring packs" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3, 5-8, and 10-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Vogel et al. (U.S. Patent Number 6,739,179 B2).

Re-claim 1 Vogel et al. disclosed, as shown in fig. 1-2, a device for suspension of a sample body 2, wherein said sample body rotates in space about a rotation axis, wherein said sample body is in a fixed position or is related to a fixed position, as a function of the intensity of a measurement effect, wherein the suspension device comprises at least two springs 4,4; wherein the sample body is designed to be planar in a rest position.

Re-claim 3 Vogel et al. disclosed, as shown in fig. 1-2, wherein the springs are composed of silicon, see col. 3, lines 54-56.

Re-claim 5 Vogel et al. disclosed, as shown in fig. 1-2, wherein the sample body and springs are composed of the same material, see col. 3, lines 54-56.

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Re-claim 6 Vogel et al. disclosed, as shown in fig. 1-2, wherein the sample body and springs are integrally connected to one another.

Re-claims 7 and 8 Vogel et al. disclosed, as shown in fig. 1-2, wherein the at least two springs are provided with one of the springs being arranged above the sample body, and the other being arranged underneath the sample body; a spring force axes of the two springs run on a line.

Re-claim 10 Vogel et al. disclosed, as shown in fig. 1-2, wherein the device is a paramagnetic oxygen measurement device, and the sample body is dumbbell-shaped.

Re-claim 11 Vogel et al. disclosed, as shown in fig. 1-2, wherein the springs are suspended such that main spring axis is at right angles to line of force of the suspension device.

Re-claim 12 Vogel et al. disclosed, as shown in fig. 1-2, wherein the springs are suspended in a suspension frame 3, said suspension frame is arranged around the sample body.

Re-claim 13 Vogel et al. disclosed, as shown in fig. 1-2, wherein the springs are at the same time used to provide electrical supply leads to the sample body.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vogel et al.

Re-claim 9 Vogel et al. disclosed, as shown in fig. 1-2, wherein one of the springs being arranged above the sample body, and the other being arranged underneath the sample body, except Vogel et al. failed to disclose wherein four springs are provided, two springs being arranged above the sample body, and two springs being arranged underneath the sample body.

It would have been obvious to one of ordinary skill in the art to provide four springs wherein two springs being arranged above the sample body, and two springs being arranged underneath the sample body in order to increase the sensitivity of the spring. Since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

9. Claims 2, 4, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vogel et al. in view of Fabinski et al. (U.S. Patent Number 5,932,794).

Re-claims 2, 4, 14, and 15 Vogel et al. disclosed wherein the springs are manufactured preferably from silicon or from a material with comparable properties by etching method, see col. 3, lines 54-58.

However Vogel et al. was silent to disclose the springs are manufactured from metal.

Fabinski et al. teaches the compression coil 4 and torsion band 8 are made from glass with metal coating.

It would have been obvious to one of ordinary skill in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gast et al. (U.S. Patent Number 3,815,018),

Kocache et al. (U.S. Patent Number 3,826,974),

Maeda et al. (U.S. Patent Number 4,860,574),

Kocache (U.S. Patent Number 5,369,980),

Hobby et al. (U.S. Patent Number 6,246,227 B1),

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Becker et al. (U.S. Patent Number 6,371,434 B1).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mariano Sy whose telephone number is 703-308-3427. The examiner can normally be reached on Mon.-Fri. from 9:00 A.M. to 3:00 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder, can be reached on 703-308-3421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 M. Sy

November 8, 2004


JACK LAVINDER
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